



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,102	03/24/2004	Akihiro Mitsui	00862.023513.	2521
5514 7590 08/08/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER NGUYEN, VAN H	
			ART UNIT 2194	PAPER NUMBER
			MAIL DATE 08/08/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/807,102

Applicant(s)

MITSUI, AKIHIRO

Examiner

VAN H. NGUYEN

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/24/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is responsive to the application filed 03/24/2004.

Claims 1-13 are currently pending in this application.

### **Oath/Declaration**

2. The Office acknowledges receipt of a properly signed Oath/Declaration submitted 06/30/2004.

### **Priority**

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### **Information Disclosure Statement**

4. The Applicants' Information Disclosure Statement, filed 05/24/2004, has been received, entered into the record, and considered.

### **Specification**

5. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

### **Descriptive Title Required**

The title of the invention is not descriptive. The title should be as "specific as possible" 37 CFR 1.72 while not exceeding "500 characters in length". The title should provide "informative value" and serve to aid in the "indexing, classifying, searching" and other Official identification functions. A new title is required that is clearly indicative of the invention to which the claims are directed. MPEP606.01

**Applicant is reminded of the proper language and format for an abstract of the disclosure.**

*The abstract should be in narrative form* and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. *The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.* The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

*The language should be clear and concise and should not repeat information given in the title.* It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### **Claim Rejections - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 12 is software per se and does not fall within one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.") During prosecution, applicant can amend to limit the claims to statutory subject matter.

### **Double Patenting**

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R.' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R.' 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Pat. No. 7, 228, 314.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application and the claims of patent'314 are claiming common subject matter. The differences between the claims in the instant application and the claims in patent'314 would have been obvious to a person of ordinary skill in the art at the time the invention was made, since the claims in the instant application represent the invention in broader scope.

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Minagawa (US 7218976 B2).**

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

**As to claims 1, 6, 11-13:**

Minagawa teaches an information processing apparatus which controls a peripheral device in accordance with set values in a device driver, comprising: a memory for holding plural conflict resolution rules to avoid a conflict among the set values in the device driver; and a processor to, in accordance with the plural conflict resolution rules read from the memory, control a status of a corresponding set value, wherein at least one of the plural conflict resolution rules includes information on application priority over other conflict resolution rules (*see the Abstract; col.6, line 10-col.8, line 13; and col.12, line 35-col.14, line 3; see also, Figs.5-18*).

**As to claims 2 and 7:**

Minagawa teaches the processor applies the respective conflict resolution rules in an order corresponding to the information on application priority (*col.12, line 35-col.14, line 3*).



**As to claims 3 and 8:**

Minagawa teaches the information on application priority is described as control information instructing to apply a subsequent conflict resolution rule related to a particular status variable, and wherein the processor extracts the control information from the read conflict resolution rules, then reads and evaluates another conflict resolution rule to be applied with a higher priority based on the control information (*col.12, line 35-col.14, line 3; see also, Figs.14-18*).

**As to claims 4 and 9:**

Minagawa teaches the set values in the device driver include information on designation of double-sided printing or bookbinding printing as a printing method and information on ON/OFF indicating whether a print data scaling function is enabled or disabled, and wherein the plural conflict resolution rules include a logic that if the double-sided printing or the bookbinding printing is designated as the printing-method, the print data scaling function is set to OFF (*see the discussion beginning at col.9, line 15; see also, Figs.14-18*).

**As to claims 5 and 10:**

Minagawa teaches the information on application priority is described, as control information instructing to apply the conflict resolution rule related to designation of the printing method with a higher priority, in a conflict resolution rule related to the print data scaling function (*col.12, line 35-col.14, line 3; see also, Figs.14-18*).

**Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Hilpl et al (US 6975417 B1).**

**As to claims 1, 6, 11-13:**

Hilpl teaches an information processing apparatus which controls a peripheral device in accordance with set values in a device driver, comprising: a memory for holding plural conflict resolution rules to avoid a conflict among the set values in the device driver; and a processor to, in accordance with the plural conflict resolution rules read from the memory, control a status of a corresponding set value, wherein at least one of the plural conflict resolution rules includes information on application priority over other conflict resolution rules (*see the Abstract; col.2, line 41-col.4, line 56; and col.6, line 12-col.8, line 9; see also, Figs.1-5*).

**As to claims 2 and 7:**

Hilpl teaches the processor applies the respective conflict resolution rules in an order corresponding to the information on application priority (*see col.6, line 12-col.8, line 9; see also, Figs.1-5*).

**As to claims 3 and 8:**

Hilpl teaches the information on application priority is described as control information instructing to apply a subsequent conflict resolution rule related to a particular status

variable, and wherein the processor extracts the control information from the read conflict resolution rules, then reads and evaluates another conflict resolution rule to be applied with a higher priority based on the control information (*see col.6, line 12-col.8, line 9; see also, Figs.1-5*).

**As to claims 4 and 9:**

Hilpl teaches the set values in the device driver include information on designation of double-sided printing or bookbinding printing as a printing method and information on ON/OFF indicating whether a print data scaling function is enabled or disabled, and wherein the plural conflict resolution rules include a logic that if the double-sided printing or the bookbinding printing is designated as the printing-method, the print data scaling function is set to OFF (*see the discussion beginning at col.3, line 39; see also, Figs.1-5*).

**As to claims 5 and 10:**

Hilpl teaches the information on application priority is described, as control information instructing to apply the conflict resolution rule related to designation of the printing method with a higher priority, in a conflict resolution rule related to the print data scaling function (*see col.6, line 12-col.8, line 9; see also, Figs.1-5*).

Art Unit: 2194

### Conclusion

9. The prior art made of record, see PTO 892, and not relied upon is considered pertinent to applicant's disclosure. Applicant should review these references carefully before responding to this office action.

### Contact Information

10. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

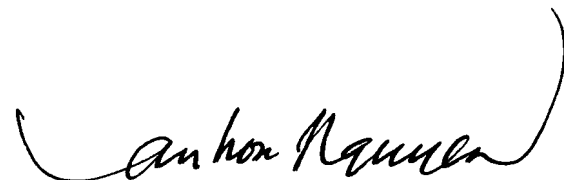
Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM-6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://padirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Commissioner for patents  
P O Box 1450  
Alexandria, VA 22313-1450



VAN H. NGUYEN  
PRIMARY EXAMINER